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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/873,597 06/12/97 KAYYEM

J A-64558-1/RF

EXAMINER

HM22/0410

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ART UNIT

PAPER NUMBER

1656

DATE MAILED:

04/10/01

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/873,597

Applicant(s)

Kayyem

Examiner
Scott Houtteman

Group Art Unit
1656



☒ Responsive to communication(s) filed on Sep 25, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 19-31 and 33-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 19-31 and 33-40 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. Applicant's response was filed 9/25/00 and a copy was refiled 1/5/01. The response has been carefully considered with the following effect:

The objection and rejections of paragraphs 3A, 3B, Office action mailed 3/16/00, have been withdrawn in view of applicant's amendments.

The objections and rejections of paragraphs 3C and 4, Office action mailed 3/16/00, have been maintained.

The rejection of paragraphs 4, Office action mailed 3/16/00, has been withdrawn with respect to claims 25-27 but maintained with respect to claims 19-24 and 28-31 and 33-40 only.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 19-31 and 33-40 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19-31 and 33-40 are indefinite in the location of the electron transfer moiety. This limitation is totally absent from all but claims 25-27. Even in claims 25-27 it is unclear how the electron transfer moiety is attached to the apparatus. With respect to the remaining claims, it is unclear whether the apparatus is claimed so that it will be used in methods that do not require an

electron transfer moiety. The specification seems to indicate that an electron transfer moiety is essential for the apparatus to function. A second possible interpretation is that the moiety is somehow included in one of the more general limitations in the claims.

Applicant argues that the electron transfer moiety can be attached at a certain positions listed in the specification. This argument is not persuasive. The claims are not limited to these attachment positions. Applicant has not argued with respect to the majority of the claims which are not limited to an electron transfer moiety.

4. Claims 19-24 and 28-31 and 33-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Ribi et al., US Pat. 5,571,568 (11/1996) filed 6/1995, effective filing date 6/15/89 (Ribi) for reasons of record.

Applicant argues, "the invention. . . relies on electron transfer between electron donor and acceptor groups (electron transfer moieties or ETMs) . . . " This argument is not persuasive. Claims 19-24 and 28-31 and 33-40 are not limited to electron transfer moieties.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Serial No. 08/873,597
Art Unit 1656

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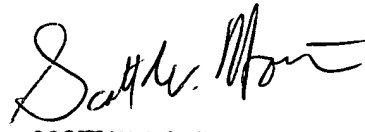
6. Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 1600 Fax numbers are (703) 305-3014 and 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Houtteman whose telephone number is (703) 308-3885. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 8:30 AM - 3:30 PM. The examiner can also be reached on alternate Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

Scott Houtteman
April 9, 2001



SCOTT W. HOUTTEMAN
PRIMARY EXAMINER